

REMARKS/ARGUMENTS

Applicant responds herein to the Office Action dated December 28, 2004.

Claim 1 stands rejected on grounds of anticipation by Nakata, et. al.(4,736,838). Claims 1, 2, 6, 7, 8 and 10 stand rejected on grounds of anticipation by Hayduchok (5,163,549). Claims 1-3, 6, 7 and 10 stand rejected on grounds of obviousness over Hayduchok, in view of Petit (5,630,508). Claims 4 and 9 stand rejected over Hayduchok-Petit, in further view of Chouinard (US 2003/0111373 A1). Finally, claims 5 and 11 stand rejected over Hayduchok-Petit, in further view of Mander (3,643,812). Reconsideration is requested in view of the amendments to the claims herein and the following remarks.

Independent claim 1 is directed to a marker holding assembly which comprises a housing that has four side walls, a bottom wall and an open top. A tray is mounted entirely within the interior of the housing, but is located "at a distance from the bottom wall". In addition, the tray has a plurality of openings into each of which a cap of a marker is securable by a snap fit. Lastly, claim 1 now adds that a cap of a marker is mounted in the opening of the tray and fixedly held with a snap fit in the tray. The cap remains in the housing when the marker is later removed. In other words, the cap of the marker is retained within the tray and thereafter, the marker is simply inserted into the tray.

Turning to the rejections of record, it is noted that rejection of paragraph 1 of the Office Action on grounds of anticipation by Nakata has been mooted by the fact that the subject matter of claim 6 has been incorporated into claim 1.

In any event, applicant traverses the assertion that Nakata discloses the structure of claim 1 prior to its being amended as in the present communication. Figure 7 of Nakata shows an element 5 which is first inserted into the case 1 and thereafter an element 9 which is inserted over the element 5. However, neither the element 5, nor the element 9 can be asserted to constitute the claimed tray of the present invention for the following reason. Although the element 5 has protrusions 7 which create a frictional contact with a possible pen or pencil that is inserted through the holes 8 and 11, nothing in the structure suggests or teaches that the cap of a marker, once inserted into these holes, becomes retained therein. To the contrary, there is no

structure that fixedly holds the cap. Indeed, it should be obvious from a reading of this reference that a writing instrument inserted through these holes is simply placed in and retrieved because the body of the writing instrument passes below the elements 5 and 9. Therefore, this reference does not teach the inventions claimed in the present application.

The reference to Hayduchok constitutes the primary and common reference utilized in all of the remaining rejections. However, applicant respectfully submits that Hayduchok does not disclose either the subject matter of claim 1, nor indeed, of any of the pending claims.

Apparently, and as evident from the second sentence of paragraph 2 of the Office Action, the Examiner is equating the claimed housing of the present invention with the structure of Figure 16 of this reference, noting that it has a housing, a portion onto which the fastening means 65b of the caddy 61 is attached. If applicant correctly comprehends the basis of the Office Action, the Examiner considers the caddy 61 of Figure 15 to correspond to the tray of the claimed invention, and since that caddy 61 has a velcro strip 65a which is attachable to a corresponding velcro strip inside the carrying case 70, it is asserted that the housing is the conventional carrying case and the tray of the present invention is the caddy 61 of Figure 15 of this reference.

Applicant traverses this (rather strained) reading of the instant claims on Figures 15 and 16 of the Hayduchok reference. Firstly, the conventional carrying case 70 of Figure 16 of this reference does not have four side walls, a bottom wall and an open top. When the “briefcase” is open, it only has three side walls and a bottom. When the briefcase is closed, it has four side walls and a bottom wall, but it does not have an “open top”.

However, in an effort to avoid the rejection altogether, the applicant has amended claim 1 to specify that the “housing” portion of the claimed invention has four fixed side walls and a bottom wall which are fixed to one another. In other words, it is a typical container inside which the tray is placed. The “briefcase” of Hayduchok is not the “housing” of claim 1.

Nor can the caddy which is identified as item 61 in Figure 15, or item 1 in Figure 1, or item 11 in Figure 9, be said to constitute the housing and tray combination of the present invention. If one were to consider any of these structures to be the “housing”, then that structure would be missing a “tray” that is located entirely within such a housing and which is provided

with a plurality of openings, each of which is provided with a structure that snappingly catches and retains the cap of a marker therein.

Since the fundamental structure of claim 1, as amended, is nowhere to be found in the primary reference, nor indeed, in any of the remaining references, it is respectfully submitted that independent claim 1 is patentable over the prior art. Similarly, all the remaining claims in the application which are dependent on claim 1 and include its limitations, and impose further limitations thereon, are clearly even more further apart from the prior art of record and, therefore, all of these claims merit to be promptly allowed.

Accordingly, the Examiner is respectfully requested to reconsider the application, allow the claims as amended and pass this case to issue.

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